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1637

SGM 6938.1
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Brian Ward et al. Art Unit 1637
Serial No. 10/002,292
Filed November 15, 2001
Confirmation No. 2146
For RECOMBINANT DNA PROCESSES USING A DNTP MIXTURE CONTAINING
MODIFIED NUCLEOTIDES
Examiner Kenneth R. Horlick

October 22, 2003

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop No Fee Amendment

COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Arlington, VA 22313-1450

SIR:

This letter is in response to the Office action dated September 22, 2003, in which an election of a Group of claims for prosecution on the merits was requested.

According to 35 U.S.C. §121, a restriction is proper only if there are at least two independent and distinct inventions. However, "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP §803 (emphasis added).

Claims 1-45, 89-120, and 155-158 of Group I are generally directed to processes for directionally ligating a double-stranded nucleic acid to a first adapter sequence, to processes

for preparing amplicons from double-stranded nucleic acids, and to processes for cloning a nucleic acid into a vector, respectively. Claims 46-88 and 136-154 of Group II are generally directed to kits for directionally ligating a double-stranded nucleic acid to a first adapter sequence and to a dNTP mixture, respectively. Claims 121-135 of Group III are generally directed to amplicons comprising a double-stranded, amplified nucleic acid fragment.

The claims of Group I relate to the claims of Group III in that the claimed processes of Group I are used to produce the claimed amplicons of Group III. The claims of Group II relate to the claims of Groups I and III in that the claimed kits of Group II are used according to the claimed processes of Group I and are used to produce the claimed amplicons of Group III. Accordingly, applicants note that the claims of Groups I, II, and III are related, and respectfully request rejoinder of Groups I, II, and III.

In addition, a search of any one of the Groups is co-extensive with a search in any one of the other Groups. A search of the art disclosing the processes for directionally ligating a double-stranded nucleic acid to a first adapter sequence, to processes for preparing amplicons from double-stranded nucleic acids, and to processes for cloning a nucleic acid into a vector will be co-extensive with a search of the art for kits (Group II) used to perform the process of Group I and with a search of the art for amplicons comprising a double-stranded, amplified nucleic acid fragment (Group III) produced by the kits of Group II and according to the processes of Group I. Accordingly, the examination of the entire application may be made without serious burden.

Subject to the foregoing traverse, applicants hereby elect the claims of Group II (claims 46-88, and 136-154) for further prosecution.

Applicants reserve the right to file divisional applications directed to the non-elected subject matter.

The Commissioner is hereby authorized to charge any underpayment or credit any overpayment to Deposit Account No. 19-1345.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Timothy B. McBride', is written over the typed name.

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